

Docket No. 08477.0099USC1

REMARKS

The application has been carefully reviewed in light of the Office Action dated January 31, 2006. Claims 41-76 remain pending in this case. Applicants reserve the right to pursue the original claims in this application and in other applications.

***Claim Rejections – 35 USC §112***

Claims 41-76 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. The Office Action states:

The claims(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Independent claims 41 and 61 recite an “online purchase of items”. The Applicant’s specification teaches a system that books travel-related reservations, but does not teach the online purchase of said reservations. Claims 55 and 70 recite “assigning points to the agent based upon the monetary value of the on-line purchase”. The Applicant’s specification does not teach this limitation.

Applicant respectfully traverses the Examiners rejection and submits that the specification does teach online purchase of reservations. Specifically the specification states:

Awards system 16 uses bonus programs to award additional credits to a travel agent based upon a predetermined activity in conjunction with a booking. Examples of predetermined activities, which may increase credits awarded, include the following: a product booked by a travel agent (for example, a travel package); lodging booked by a travel agent (for example, a type of hotel); when a travel agent books the travel-related reservation; when a customer who requested the travel-related reservation used the travel-related reservation; how a customer pays for the travel-related reservation (for example, using a particular type of credit card) ... (page 10 lines 12-27)

Regarding claims 55 and 70, the Examiner states that “[c]laims 55 and 70 recite ‘assigning points to the agent based upon the monetary value of the on-line purchase’. The Applicant’s specification does not teach this limitation.” Applicant respectfully submits that the

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specification does teach assigning points to the agent based upon the monetary value of the on-line purchase. Specifically the specification states:

FIG. 4 is a flow chart of a process for calculating credits. Awards system 16 typically awards credits based upon the revenue for a particular travel-related reservation booking, which occurs at step 52. Other types of calculations for credits are possible. (page 9 lines 31-33)

***Claim Rejection – 35 USC §103***

Claims 41-76 are rejected under 35 U.S.C. §103(a) as being unpatentable over Roach et al. (U.S. Patent No. 5,434,394) hereinafter *Roach*.

Regarding claim 41, Examiner states:

As per claims 41, *Roach* et al teach:

A computerized on-line incentive system for awarding points to a user conducting an on-line purchase, the system comprising:

(a) an access device connected to a network (see column 5, lines 45-55; figure 1);

(b) a computerized on-line sales environment, connected to the network and thereby accessible to the user of the access device, the on-line sales environment permitting the user to determine items that are for sale and conduct an on-line purchase of said items (see figure 1, column 5, line 45 – column 7, line 39; column 9, lines 51-61; column 12, lines 25-39). *Roach* teaches in column 12, lines 24-39 that “a determination is made whether the selected item of merchandise is in stock. If the selected item is not in stock, in step 332 the computer 18 prompts the operator to suggest products comparable to the unavailable merchandise by displaying information of the screen of the computer. In step 334, a determination is made whether the customer desires information concerning products comparable to the unavailable merchandise. If the customers desires information concerning products comparable to the unavailable merchandise, the computer 18 in step 336 displays comparable product information”. Therefore, *Roach* system advises a user whether items desired to be purchased are available for purchase prior to purchase, and if said items are not available, *Roach* provides said user with alternative items (see column 13, lines 45-50).

(c) an on-line award system connected to the network, the on-line award system being in communication with the on-line sales environment and possessing an account holding a point total corresponding to the user (see column

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7, lines 1-39; column 9, lines 51-63; column 10, lines 35-67; column 11, line 44–column 12, line 15; column 13, lines 1-30). Roach does not teach that said user is an agent. However, Official Notice is taken that it is old and well known in the business art for a customer to make purchases for said customer's employer. For example, when a customer makes a purchase for said customer's employer, said customer is acting as an agent for said employer. It would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that a customer using the Roach's online incentive system would be motivated to act as an agent for said customer's employer in view that said customer would receive rewards for making purchases for said customer's employer and in view that said customer would be doing his job as said employer's agent by placing said purchases for said employer.

Regarding claim 61, Examiner states:

As per claim 61, Roach et al teach:

A computerized on-line method for awarding points to a user conducting an on-line purchase, comprising the steps of:

(a) receiving on-line purchase information from the user via an access device connected to a network (see column 10, lines 1-35);

(b) determining availability of an item to be purchased (see column 12, lines 21-38);

(c) communicating the on-line purchase information to an awards system following the purchase of said item (see column 7, lines 1-39; column 9, lines 51-63; column 10, lines 35-67; column 11, line 44 – column 12, line 15; column 13, lines 1-30);

(d) awarding points to the user based on the on-line purchase information (see column 19, lines 15-30); and

(e) cumulating the points in a specified account for the user (see column 19, lines 15-30). Roach does not teach that said user is also an agent. However, the same rejection applied to claim 41 regarding said missing limitation is also applied to claim 61.

Applicant respectfully traverses the Action's rejection. Courts have generally recognized that a showing of a *prima facie* case of obviousness necessitates three requirements: (i) some suggestion or motivation, whether in the references themselves or in the knowledge of a person of ordinary skill in the art to modify the reference or combine the reference teachings; (ii) a

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reasonable expectation of success; and (iii) the prior art references must teach or suggest all claim limitations. MPEP §2143; *In re Dembiczak*, 175 F.3d 994 (Fed. Cir. 1999); *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998); *Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc.*, 75 F.3d 1568, 1573 (Fed. Cir. 1996).

Applicants respectfully submit that the reference used in the Action fail the third prong of obviousness. Claims 41 and 61 are patentably distinguishable over the cited references for the reason that, *inter alia*, they recite a computerized on-line method for awarding points to an agent conducting an on-line purchase for a customer. In order to make a *prima facie* case of obviousness, the Examiner must set forth prior art which teach or suggest every claim limitation. MPEP §2143.

Per the Examiner's admission, "Roach does not teach that said user is an agent." The Examiner has taken Official Notice that it is old and well known in the business art for a customer to make purchases for said customer's employer, thereby being a *de facto* agent of the employer. If the Examiner continues to rely on this unsupported contention, Applicants respectfully request the Examiner to provide support. See, *In re Zurko*, 258 F.3d 1379, 59 U.S.P.Q.2d 1696 (Fed. Cir. 2001) holding that the USPTO must point to some concrete evidence in the record to support core factual findings in a determination of patentability; Memorandum by Stephen G. Kunin, Deputy Commissioner for Patent Examination Policy (February 21, 2002) stating that it is never appropriate to rely on common knowledge without evidentiary support as sole or principal evidence on which to base rejection; 37 C.F.R. §1.104 provides that when a rejection in an application is based on facts within the personal knowledge of an Examiner, the data should be stated as specifically as possible, *and the facts must be supported*, when called for by the applicant, by an affidavit from the Examiner; MPEP § 2144.03 provides that the Examiner may only take office notice of facts outside of the record which are capable of instant and unquestionable demonstration as being "well-known" in the art and, if the Applicant traverses such an assertion, the Examiner *should cite a reference* in support of his or her position.

Should the Examiner find the above remarks non-persuasive, Applicants respectfully submit that the reference used in the Office Action additionally fail the third prong of obviousness. Amended claims 41 and 61 are patentably distinguishable over the cited reference

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for the reason that, *inter alia*, they recite a computerized on-line incentive system for awarding points to an agent conducting an on-line purchase for a customer, wherein the agent is not an employee of the customer. Per the Office Action's admission, "Roach does not teach that said user is an agent" or that the agent is not an employee of the customer.

Claims 42-60 depend directly or indirectly from claim 41, and claims 62-76 depend directly or indirectly from claim 61, and are allowable along with claims 41 and 61, respectively, for the reasons mentioned above and on their own merit.

Regarding the Examiner's additional assertions, which have not been addressed specifically, Applicant respectfully submits that these arguments are moot in view of the above comments and the amendment to the claims. Applicant respectfully submits that claims 41-76 are in condition for allowance.

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**CONCLUSION**

In view of the foregoing remarks, Applicants respectfully request the reconsideration and reexamination of this application and the timely allowance of the pending claims. The preceding arguments are based only on the arguments in the Action, and therefore do not address patentable aspects of the invention that were not addressed by the Action. The claims may include other elements that are not shown, taught, or suggested by the cited references. Accordingly, the preceding arguments in favor of patentability are advanced without prejudice to other bases of patentability. Furthermore, the Action contains a number of statements reflecting characterization of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to and statement or characterization in the Action.

Please grant any extensions of time required to enter this response and charge any additional required fees to deposit account 13-2725.

If the Examiner believes a telephone conference would advance the prosecution of this application, the Examiner is invited to telephone the undersigned at the below-listed telephone number.

Respectfully submitted,

MERCHANT & GOULD P.C.  
P.O. Box 2903  
Minneapolis, Minnesota 55402-0903  
(404) 954-5100

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Alan G. Gorman  
Reg. No. 38,472

